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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/690,669 | 10/23/2003 | Matthew Lerner | 003797.00675 | 5871 |
| 27195 7590 07/17/2008 AMIN, TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114 | | | | |
| EXAMINER RUTLEDGE, AMELIA L. | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2176 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 07/17/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

| | |
|--------------------------------------|--------------------------------------|
| Application No. 10/690,669 | Applicant(s) LERNER ET AL. |
| Examiner AMELIA RUTLEDGE | Art Unit 2176 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Doug Hutton/
Supervisory Patent Examiner
Technology Center 2100

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed 06/30/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the claimed "file preview operation" of claim 1 (Remarks, p. 6-7), as set forth in the final office action mailed 05/07/2008, Moran teaches that the title may be rendered as part of a file preview operation (col. 13, l. 20-29), since Moran discloses that the user may expand the information about a domain object by double tapping on the icon, this will result in another layout of the domain object being displayed as an overlay, i.e., file preview.

While applicant argues that "expanding the information about a domain object [icon]" is not equivalent to a "file preview" operation, the examiner disagrees. Claim 1 recites rendering "the stored property value in electronic ink format as part of a file preview operation". A file preview supplies information to a user about a file. It should be noted that claim 1 does not claim rendering the entire file, but only a stored property value, such as a title for a file. Nor does claim 1 recite displaying any changed information, therefore, applicant's argument that "What is discussed in Moran would not be considered a preview since information does not change" is directed to features not recited in the claim, since claim 1 is not limited to changed information, but rather renders a stored property value, which is disclosed by Moran (col. 13, l. 20-29).

While applicant argues that the office action does not state which reference discloses "an input system that receives a file save command" (see Remarks, p. 7, par. 3), page 3, par. 3, l. 1-7 of the final office action relies on Moran combined with Saund to teach the limitation. While in the rest of the rejection of claim 1 each of the claim limitations was copied, placed in italics, and mapped line by line to the reference, in this paragraph the claim limitation was paraphrased by the examiner. Moran strongly suggests the limitation "an input system that receives a file save command, since Moran teaches that the system receives a property value of a document or file on the system in electronic ink format (col. 21, l. 25-51; col. 22, l. 8-23). Moran teaches that the property value is received as part of a file or document save operation because Moran teaches that system operations can be associated with user actions and the class definition of a domain object (col. 9, l. 50-col. 10, l. 10), therefore Moran suggests that the domain objects, i.e., property values may be received as part of a file or document save operation.

Saund explicitly teaches that the electronic ink board allows a user to draw interface elements representing save actions (Fig. 31, 33) and performing file save commands for electronic ink property values in the save interface (col. 6, l. 45-col. 7, l. 64). For example, Saund teaches rendering an electronic ink file save interface and saving an image file or text (col. 7, l. 5-38).

In response to applicant's arguments regarding claim 12, which recites "an electronic ink author identification", in addition to the portions of Moran cited in the rejection of claim 12, Moran teaches an author identification at (col. 20, l. 51-64), as well as the electronic ink labels for property values cited in the claim rejection (col. 13, l. 13-col. 14, l. 23; claim 1).

For these reasons, it is the examiner's opinion that the claim rejections should be maintained..